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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,627	06/28/2006	Donald Taylor Likes	DC5156 PCT1	7119

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EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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04/17/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

# Office Action Summary

## Application No.

10/566,627

## Applicant(s)

LILES ET AL.

## Examiner

Margaret G. Moore

## Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 to 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date 1/30/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

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1. The Examiner has reviewed the IDS filed 1/30/06. Please note that the document 5,356,585 is not, in fact, the Be et al. reference and as such a line has been drawn through this citation.

2. To clarify the claimed invention, the Examiner makes the following points. First note that the claimed composition uses the term "comprising" and as such it is not limited to the components specifically recited in the claim. Also note that the composition of claims 1 and 7 need not contain water, since it is possible to obtain 100 weight percent without there being a balance of water.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Takamizawa et al.

Takamizawa et al. teach a water repellent agent that contains a methylhydrogen-siloxane, a silanol endblocked siloxane, a resin, a surface active agent and water. See for instance Preparation D on column 6. This anticipates the instant claims.

5. Claims 1, 2, 4 to 8, 10 to 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher et al.

Fisher et al. teach an aqueous emulsion for rendering surfaces water repellent. Column 3 teaches the Si-H siloxane meeting (i) and claim 2. Column 3, lines 64 and on, teaches a silicone resin including MQ resins of claim 4. The bottom of column 4 through column 5 teaches the addition of a silanol functional aminosiloxane that meets (ii). Please note the top of column 7 which teaches amounts of each ingredient that fall within the instant claims. This includes an additive meeting (v) in claim 7. See also column 7, lines 51 and 52, which meet the particle size requirement of claim 13.

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6. Claims 1 to 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Berg et al.

Berg et al. teach a shelf stable emulsion composition. See for instance Example 10 which shows an emulsion containing a silanol terminated siloxane, water, a methyl-hydrogen siloxane copolymer and a surface active agent. Column 31, lines 38 and on, teach the addition of a silsesquioxane resin. See also claim 3 which teaches the addition of an MQ resin. In this manner Berg et al. anticipate each of the required components. Column 32, lines 11 to 15, teaches the necessary additives of claim 7. Note also that that the emulsion in Example 10 contains an amine which column 32, line 4 and on, indicates is a stabilizer.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 to 4, 6 to 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrifield et al.

Merrifield et al. teach water repellent emulsion compositions that contain an Si-H siloxane meeting (i) and different high molecular weight silicones. As can be seen from column 3 and the working examples, these silicones include both silanol terminated siloxanes, meeting (ii), and MQ resins, meeting (iii). The emulsions also contain water and a surfactant (column 4, lines 5 to 23). This differs from the claims in that patentees do not specifically show a mixture of (ii) and (iii) as claimed.

Please note that it is prima facie obvious to combine two compositions, each of which is taught by prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea for combining said compositions flows logically from their having been individually taught in the prior art. With this in mind, one having ordinary skill in the art would have found the combination of two

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emulsions, one containing a methylhydrogensiloxane and an MQ resin and one containing a methylhydrogensiloxane and a silanol terminated siloxane (both of which are found individually in Merrifield) in an effort to form a third water repellent composition obvious.

For claim 7, the Examiner notes that the composition in Merrifield et al. is used to render wallboard water repellent. As such the addition of additives which would extend the life of wallboard, such as a UV light stabilizer or absorber or a mildewcide, would have been obvious to one having ordinary skill in the art in an effort to take advantage of the known benefits and properties associated therewith.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
4/11/08